

## **REMARKS**

This is intended as a full and complete response to the Office Action dated November 17, 2009, having a shortened statutory period for response set to expire on February 17, 2010. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-4, 6 and 13-19 are pending in the application. Claims 1-4, 6 and 13-19 remain pending following entry of this response. Claims 1, 4 and 13-19 have been amended. Applicants submit that the amendments do not introduce new matter.

Further, Applicants are not conceding in this application that those amended (or canceled) claims are not patentable over the art cited by the Examiner, as the present claim amendments and cancellations are only for facilitating expeditious prosecution of the claimed subject matter. Applicants respectfully reserve the right to pursue these (pre-amended or canceled claims) and other claims in one or more continuations and/or divisional patent applications.

### Claim Rejections - 35 U.S.C. § 101

Claims 14-19 are rejected under 35 U.S.C. § 101 because the Office Action asserts that the claims are directed to non-statutory subject matter. Specifically, the Office Action states:

Claim 14 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim recites in the preamble a computer program device, while the body recites a combination of means and logic means. However, it is unclear whether the claim pertains to a computer program product or a computer device, which is statutory, whereas “computer program device” in itself is not statutory under 35 USC 101 or does not pertain to a statutory class.

Office Action, page 2.

With this response, Applicants have amended claims 14-19 to recite a “computer readable storage medium.” Applicants submit that the claims, as amended, are directed to statutory subject matter. Accordingly, Applicants respectfully submit that the rejection is obviated.

Claim Rejections - 35 U.S.C. § 112

Claims 13-19 are rejected under 35 U.S.C. § 112, second paragraph because the Office Action asserts that the claims are indefinite. Specifically, the Office Action states:

Claim 13 recites, in the body of the claim, “logical means.” However, “logic” represents a module or software, whereas “means” represents structure. Thus, “logic means” has no apparent meaning in itself and thus, it is said to be confusing. . . . Further, “computer readable medium means” [of claim 14] is confusing.

Office Action, page 3.

With this response, Applicants have amended claim 13 to recite “a program which, when executed, performs an operation for saving Internet advertisements . . . .” Further, Applicants have amended claims 14-19 to recite a “computer readable storage medium.” Applicants submit that the claims, as amended, are not indefinite. Accordingly, Applicants respectfully submit that the rejection is obviated.

Claim Rejections - 35 U.S.C. § 102

Claims 1-4, 6 and 13-19 are rejected under 35 U.S.C. § 102(a) because the Office Action asserts that the claims are anticipated by *Rice* (US 6,486,891).

Applicants respectfully traverse this rejection.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990).

In this case, *Rice* does not disclose “each and every element as set forth in the claim.” For example, the Office Action suggests that *Rice* discloses “receiving Internet advertisements at the user computer automatically without the user requesting them.” Specifically, the Final Office Action states:

Rice discloses . . . receiving internet advertisements at the user computer automatically without the user requesting them (column 5, lines 25-30 “At step 340, in response to the first type of ad selection, the server causes the client to receive a web page associated with the advertisement, such as the home page of the advertiser, a particular promotional page from the advertiser’s web site, or some other web page the advertiser chose to associate with the advertisement”) . . . .

Office Action, page 5 (emphasis added). Respectfully, the client in *Rice* receives the web page *in response to the selecting an ad*. See, e.g., *Rice*, col. 5, lines 20-22 (“At step 335, the type of ad selection associated with the ad request is determined.”). Therefore, *Rice* cannot teach receiving Internet advertisements at the user computer automatically without the user requesting them, as required by the claims. Accordingly, Applicants respectfully submit that the rejection is defective and should be withdrawn.

Further, the Office Action suggests that *Rice* discloses “executing software code to automatically identify and save the advertisements at the user computer.” Specifically, the Office Action states:

Rice discloses . . . executing software to automatically identify and save the advertisement at the user computer (column 2, lines 20-30 “The Bookmark Banner also includes an area that causes the source of the advertisement to be bookmarked in the user’s web browser, for example. Subsequently, the user may view the source of the advertisement by selecting the previously created bookmark”) . . . .

Office Action, page 5. *Rice* teaches bookmarking (i.e., saving a URL of) a web page that an advertiser chose to associate with an advertisement. Respectfully, persons having ordinary skill in the art will recognize that saving a URL of a web page is not the same as saving the web page itself. In the former, using the saved URL, the web page is accessed from a remote server hosting the web page, subject to availability of the remote server and/or the network. In the latter, the saved web page is retrieved locally and without any involvement on the part of the remote server. Therefore, saving an address of the webpage is not the same as “saving the advertisement at the user computer.” Consequently, *Rice* fails to teach “executing software code to automatically identify and save the advertisements at the user computer.” On this basis alone, Applicants respectfully submit that the rejection is defective and should be withdrawn.

Further, as described above, *Rice* teaches bookmarking (i.e., saving a URL of) a web page that an advertiser chose to associate with an advertisement. That is, *Rice* teaches saving a URL of the *associated web page* – i.e., rather than saving the advertisement itself at the user computer. To illustrate this distinction, suppose that the user in *Rice* views a graphical banner ad from ABC Movie Company that advertises free shipping on DVDs. The graphical banner ad need not identify ABC Movie Company by name. For example, the graphical banner ad may simply include an image of a delivery truck along with the text “Free Shipping on DVDs – Click Here.” Further, ABC Movie Company may associate the graphical banner ad with a web page. For example, ABC Movie Company may associate the graphical banner ad with the main page of its website (e.g., <http://abcmovie.tld/>). Alternatively, ABC Movie Company may associate the graphical banner ad with a “most popular movies” page of its website (e.g., <http://abcmovie.tld/most-popular/>). Respectfully, persons having ordinary skill in the art will recognize that saving the URL of (or even the content from) the main page or the “most popular movies” page is not the same as saving the graphical banner ad that advertises free shipping on DVDs. Simply put, while the graphical banner ad may attract and/or direct visitors to the website of ABC Movie Company, the graphical banner ad itself need not exist on the website of ABC Movie Company. In this regard, *Rice* is silent on saving the advertisement itself (e.g., the graphical banner ad) at the user computer. Therefore, *Rice* fails to teach “executing software code to automatically identify and save the advertisements at the user computer.” On this basis also, Applicants respectfully submit that the rejection is defective and should be withdrawn.

Further, Applicants have amended claim 13 to recite selecting and accessing steps. Applicants have also amended claim 14 to recite a recalling step. Applicants submit that claims 13 and 14, as amended, are not taught by *Rice*. For example, *Rice* fails to teach at least “selecting, based on user input, one or more of the saved advertisements for display thereof”, “accessing the website from the selected saved advertisement when the link is toggled”, and “recalling at least one user-selected advertisement from the saved advertisements, for display in an advertisement history window displaying Internet content composed only of advertisements”. Accordingly,

Applicants respectfully submit that the rejection is obviated with respect to claims 13 and 14.

Therefore, the claims are believed to be allowable, and allowance of the claims is respectfully requested.

Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted, and  
**S-signed pursuant to 37 CFR 1.4,**

/Gero G. MCCLELLAN, Reg. No. 44,227/

---

Gero G. McClellan  
Registration No. 44,227  
PATTERSON & SHERIDAN, L.L.P.  
3040 Post Oak Blvd. Suite 1500  
Houston, TX 77056  
Telephone: (713) 623-4844  
Facsimile: (713) 623-4846  
Attorney for Applicant(s)